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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/665,190	09/12/2000	Thelma G. Manning	95-18A2	9011

7590 09/16/2002

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EXAMINER

MILLER, EDWARD A

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 09/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/665,190

Applicant(s)

MANNING ET AL.

Examiner

Edward A. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6-15 is/are pending in the application.
- 4a) Of the above claim(s) 6-12, 14 and 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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1. The reply filed on 18 July 2002 is not fully responsive to the prior Office Action because of the following omission(s) or matter(s):

a) The declaration submitted is improper since it refers to an application different from the instant application. See Paper No. 7, paragraph 8, which required applicant to submit a new oath or declaration, properly identifying the application of which it is to become a part by serial number and filing date, e.g. If applicants consider the serial number, in the heading of the various instant communications from the Office, for example, as well as their filing receipt, they will see that the instant application serial number is not "09/351,350". Further, the instant filing date is September 12, 2000, not July 12, 1999. Consider 35 U.S.C. 112, second paragraph:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

By statute, the claims conclude, that is are part of, the last section of, the specification. As instant amended claims 6-15 were not present in SN 09/351,350, but were filed as part of the instant application, the declaration language is incorrect. The filing of a correct declaration is required. However, see paragraphs "b)" and "c)", below.

b) Applicant failed to properly amend the "Cross Reference to Related Applications" to show the complete relationship of all the related applications. The original continuation application transmittal form refers to SN 09/351,530, filed July 12, 1999. Thus, the instant amendment to add the same serial number again is obviously not in compliance with the requirement. It appears that applicants' filing receipt also refers to an earlier application SN 09/038,490, filed March 06, 1998. Since this date is more than 12 months after the filing date of provisional application 60/006,671, filed 11/13/1995, the benefit thereof is denied. There is significant doubt as to whether the instant reply is in fact bona fide, under 37 CFR 1.135(c), but the benefit will be granted in this instance. Further, in the various parent applications, the contents were rejected under 35 USC 112, 1<sup>st</sup>

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paragraph, for new matter. In none of these cases, did applicants appeal the determination of the examiner. Thus, as to each such parent application which contained new matter, in which applicant acquiesced, the respective application would appear to be a continuation in part of the parent application. Applicants are required to present a correct cross reference indicating continuation in part status where such is appropriate. See also the next paragraph, as to the instant application. It is noted that the question of the instant application being a c-i-p of its respective parent application has not been finalized or perfected yet. Should applicants disagree on this point, they are required to present arguments fully pointing out the basis for a determination that the application remains a continuation, instead of a continuation in part.

c) As to the instant new claims, applicants were required to point out the basis of the new matter in the claim language, not merely the specific mentioned part, in Paper No. 7, paragraph 6. Applicants failed to do so. In further detail, as to claim 13 only as the other claims are withdrawn from consideration, note the following additional examples. In this consideration, each line of the claim is numbered, counting only lines with content. In claim 13, lines 6-8, there is no basis for the polymer language. The only basis apparent is found on page 4 of the specification, which refers only to AMMO/BAMO copolymers, and polymer being obtained from a commercial source. This does not support the language that the monomers BAMO or AMMO are polymers, or that a "monopolymer" (so to speak) rather than a copolymer is described. In lines 8-9, no basis has been pointed out or found for "until ... melts". In lines 10-14, although the fillers are correctly identified, there is no basis pointed out that a filler that is solely CL-20 may form a "slow" burn rate composition as recited in lines 15-16. In lines 17-19, basis for "cooling" from 55° to 91° is not pointed out. Similar occurrences are found in the second propellant part, although the filler part would be no basis for a fast propellant with solely RDX filler. As to the original example in Paper

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No. 7, the two co-extruded propellants, applicants' response is obviously deficient. To allege that the attorney used no reference other than the specification is unrelated to the requirement. With sole reference to the specification, the examiner can make up an energetic oxetane copolymer of TNAZ-BAMO. Of course, such ignores chemical reality, but all the words come from the specification. Mixtures of propellants are taught, which have divergent burning rates, with emphasis on the difference in the burning rates, but with similar impetus properties, specification page 2. Tank rounds contain propellant grains, as is well known in the art. This is distinct from an extruded rocket grain which is monolithic. Using a combination of two equi-energetic propellants, specification page 2, lines 16-21 clearly requires, for the slower burning propellant to enter **the cycle at a later time**, the grains of the first propellant must substantially burn in the first portion of **the cycle**, so the second, slower burning grains may enter the cycle at a later time, as taught by the specification. This is what has basis in the specification, and it is common sense. In each instance in the specification, as in Tables I and II, the teachings are to extrude a single propellant to form propellant grains of that single propellant. Thereafter, the extruded propellants are combined, e.g., individual extruded grains may be mixed, but with no suggestion of any additional extrusion. On specification page 6, lines 30-34 and the paragraph bridging pages 6-7, each propellant was prepared by mixing the ingredients of the noted propellants and extruding the individual propellant composition. Each Sample, A-G, has a certain amount of oxetane, and a different amount of a single filler. Each is mixed and extruded. In "Table III", page 8, extrusion temperatures are given for each A-G identified sample. Throughout the specification, wherever any Table or examples follow, they are solely of examples A-G. There is no teaching of any co-extrusion, the required method step in claim 13, part "c." at the end of the claim. Nowhere has applicant pointed out any basis for combining propellants of a plurality of propellant samples A-G, melting (or otherwise

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heating to extrusion temperature) the mixture of a plurality of samples, and then co-extruding a plurality of samples to form a monolithic mixture. A monolithic block is obtained when one co-extrudes. The question is not whether such is physically possible or can be done, the question is basis in the specification as originally filed. The question of mixing of propellants (mixing of grains) is not the question, it is extruding such a mixture. Further, the specification continually refers to the ratio of the burning rates, which is informed by the early part of the specification. As is notoriously well known, when one mixes ingredients that are well known and combined for their known properties, the combination will have an average of the properties, compare *In re Crockett*, 126 USPQ 186, *In re Pinten*, 173 USPQ 801, and *In re Sussman*, 43 CD 518. Thus, according to this well known averaging of properties, melting, mixing and extruding would make a composition which has a composite or average of the properties, instead of a mixture of individual elements or grains, each retaining its individual properties. In the response, there is some doubt whether applicants have made a good faith attempt to do what Paper No. 7, paragraph 6 required.

2. See 37 CFR 1.111. [emphasis added.]

....

(b) In order to be entitled to reconsideration or further examination, the applicant or patent owner must reply to the Office action. The reply by the applicant or patent owner must be reduced to a **writing which distinctly and specifically points out the supposed errors in the examiner's action and must reply to every ground of objection and rejection in the prior Office action.** The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. If the reply is with respect to an application, a request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated. The applicant's or patent owner's reply must appear throughout to be a bona fide attempt to advance the application or the reexamination proceeding to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section.

(c) In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. The applicant or patent

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owner must also show how the amendments avoid such references or objections.

3. See § 1.135 Abandonment for failure to reply within time period.

....  
(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section **must include such complete and proper reply as the condition of the application may require**. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

(c) When reply by the applicant is a bona fide attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

4. In accordance with 37 CFR 1.135(c), applicant is given a new time period for reply. Should applicants again fail to properly comply with the requirements, the application will be held abandoned for failure to take complete and proper action, 37 CFR 1.135(b).

5. Since the above-mentioned reply appears to be *bona fide*, applicant is given **ONE (1) MONTH or THIRTY (30) DAYS** from the mailing date of this notice, whichever is longer, within which to supply the omission or correction in order to avoid abandonment. **EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).**

6. Any inquiry concerning either this or an earlier communication from the Examiner should be directed to Examiner Edward A. Miller at (703) 306-4163. Examiner Miller may normally be reached Monday-Thursday, from 10 AM to 7 PM.

If attempts to reach Examiner Miller by telephone are unsuccessful, his supervisor Mr. Carone can be reached at (703) 306-4198. The Group fax number is (703) 305-7687.

If there is no answer, or for any inquiry of a general nature or relating to the application status, please call the Group receptionist at (703) 308-1113.

Miller/em  
September 13, 2002

  
**EDWARD A. MILLER**  
**PRIMARY EXAMINER**